

REMARKS

In response to the Office Action mailed August 6, 2003, please amend the application as set forth in the present amendment. Entry of the amendment and reconsideration of the application is respectfully requested.

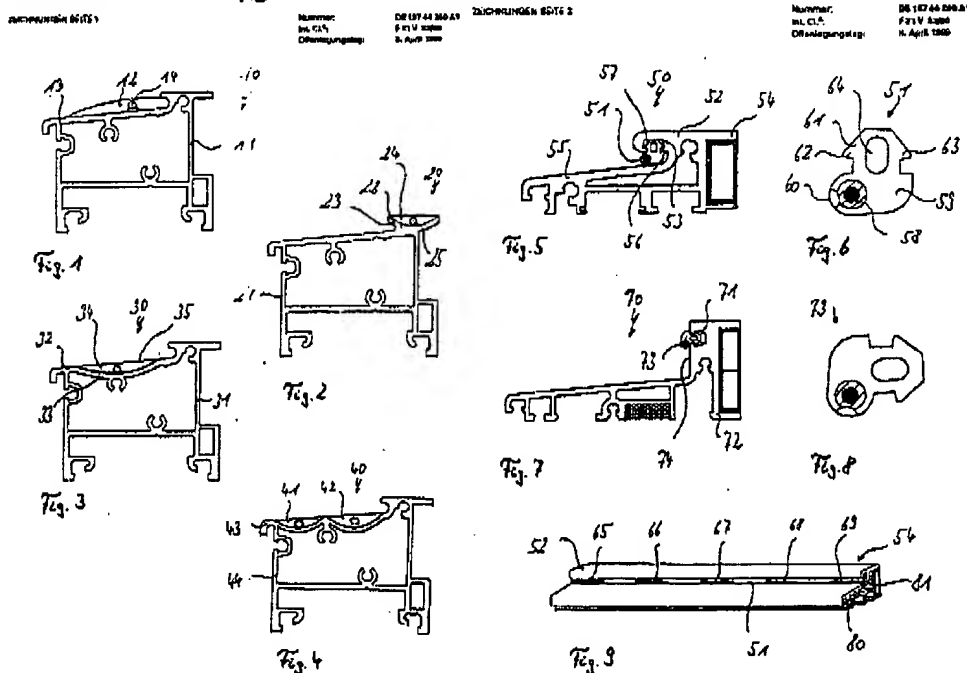
Rejections Under 35 U.S.C. §102

German Patent Publication 197 44 240

Claims 1-3, 9, 55, 56, 57, 63 and 64

Claims 1-3, 9, 55, 56, 57, 63 and 64 stand rejected under 35 U.S.C. §102(b) as being anticipated by German Patent Publication 197 44 240 (the '240 reference). Examiner Strimbu relies upon the '240 reference to disclose a vehicular weatherseal 73. [Paper 21, Page 2]

Applicant respectfully submits the '240 reference does not disclose a *vehicular* weatherseal, but rather discloses a *building door threshold* illuminating device. As seen in Figures 1-5, 7 and 9 of the '240 reference, a door threshold 10, 20, 30, 40, 50, 70 and 54, respectively shows a sill for a residential or building door. There is no disclosure or suggestion of a vehicular weatherseal.



The examiner has not identified, nor can applicant locate any portion of the '240 reference which indicates the seal is a vehicular weatherseal. In contrast, an unofficial translation of the '240 reference sets forth the device so as to meet architectural constraints to provide a door threshold with a stepping surface. Applicant respectfully submits this is not a vehicular weatherseal.

Further, the examiner asserts the '240 reference discloses "a sealing portion (not numbered)" [Paper 21, Page 2]

The rejected claims recite in part "the sealing portion adapted to contact the second confronting surface in the adjacent closed position of the confronting surface." (Claims 1-3, 55, 56, 57 and 63)

Applicant respectfully submits there is no disclosure in the '240 reference that the illuminating insert 73 contacts a confronting surface, such as a door. No portion of the '240 reference has been identified that discloses the recited seal and relation to the confronting surfaces. As this limitation is missing, the '240 reference cannot sustain a rejection under 35 U.S.C. §102.

Claims 1-3 and 9

Each of Claims 1-3 and 9 recite in part, "an improved *vehicular* weatherseal . . . the improvement comprising . . . the polymeric body including a sealing portion . . . the sealing portion adapted to be spaced from the second confronting surface in the spaced apart open position of the confronting surfaces, *the sealing portion adapted to contact the second confronting surface in the adjacent closed position of the confronting surfaces . . .*" [emphasis added]

As the '240 reference does not disclose any of these limitations, applicant respectfully submits Claims 1-3 and 9 cannot be anticipated by the '240 reference.

Claims 55, 56, 57, 63 and 64

Claims 55, 56, 57, 63 and 64 recite in part "an improved *vehicular* weatherseal . . . the improvement comprising . . . an elongate polymeric body including a sealing portion . . . the sealing portion adapted to be spaced from the second confronting surface in the spaced apart open position of the confronting surfaces and *the sealing portion adapted to contact the second confronting surface in the adjacent closed position of the confronting surfaces . . .*" [emphasis added]

As neither of these limitations are shown or disclosed in the '240 reference, applicant respectfully submits the '240 reference cannot sustain rejection under 35 U.S.C. §102.

Rejections Under 35 U.S.C. §103

Claims 1-9, 13-17, 20-23, 42-76 stand rejected under 35 U.S.C. §103 as being unpatentable over Van Den Oord (U.S. Patent No. 6,442,902) in view of the '240 reference and German Patent Application No. 198 41 180 (the '180 reference). [Paper 21, Page 3]

Examiner Strimbu asserts it would have been obvious "to provide Van Den Oord with a pair of side emitting optic glass fiber cables, as taught by German Patent Publication No. 198 41 180 in the sealing portion of Laughman, et al. [sic Van Den

Oord] as taught by German Patent Publication No. 197 44 240, to eliminate the area surrounding the door opening for safety." [Paper 21, Pages 2-3]

Most, if not all inventions arise from a combination of old elements.

Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. [citations omitted] *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000)

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. [citations omitted] *Id.* at 1317.

The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. Broad conclusory statements standing alone are not "evidence." [citations omitted] *Id.* at 1317.

Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the

essence of hindsight. [citations omitted] *Ecolochem v. Southern California Edison Co.* 56 USPQ2d 1065, 1073 (Fed. Cir. 2000).

Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *Id.* at 1073 "The opinion then lists each step and states where in the cited prior art references the step can be found. This reference-by-reference, limitation-by-limitation analysis wholly fails to demonstrate how the prior art teaches or suggests the combination claimed in the '411 patent. *Ecolochem* at 1075.

A rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention would have selected these components for combination in the manner claimed. *Ecolochem* at 1076.

In *In re Dembiczak*, we noted that:

Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

We "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988). *Ecolochem* at 1072.

The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'")

(quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)); *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002)

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references"). *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002)

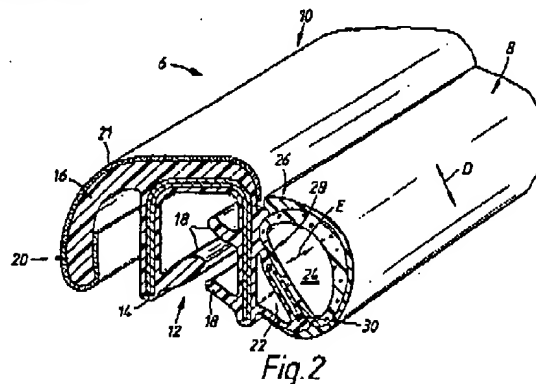
With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002)

In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention. See, e.g., *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) (When the patent invention is made by combining known components to achieve a new system, the prior art must provide a suggestion, or motivation to make such a combination."); *Northern Telecom v. Datapoint Corp.*, 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990) (It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor."); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044,

1044, 1051, 5 USPQ 1434, 1438 (Fed. Cir. 1988) *Karsten Manufacturing v. Cleveland Golf*, 58 USPQ2d 1286 (Fed. Cir. 2001)

Van Den Oord

Applicant recognizes the primary reference Van Den Oord, relates to a vehicular weatherseal. However, Van Den Oord is directed to a sealing strip having a sealing part defining a longitudinal hollow interior which becomes partially compressed in use to carry out a sealing function, wherein the hollow interior has an interior wall extending across it.



Van Den Oord is expressly directed to an interior wall for a hollow sealing strip which resists partial collapse of the hollow interior under longitudinal bending forces of the sealing strip. There is absolutely no disclosure or suggestion of safety features nor illuminating any portion of the weatherstrip. Nor is there any disclosure of the seal acting as a stepping surface.

In contrast, both the '240 reference and '180 reference are directed to structural (building) doors and do not disclose or suggest any combination with a vehicular weatherseal. The disclosure of a building door does not suggest combination or interchangeability with a vehicular weatherseal. Building doors vehicle seals are required to meet different seal requirements, different closure forces, different seal tolerances and different confronting surface motions. More particularly, building door threshold seals have substantially different cycling requirements, loading and environmental tolerances than vehicular weatherseals. Therefore, building door threshold seals are not suggestive of combination with vehicular weatherseals.

The fact that vehicular weatherseals previously existed does not provide motivation, suggestion or teaching the desirability of modifying such a vehicular weatherseal in view of a structural door sill or threshold.

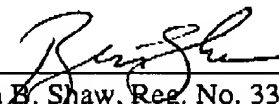
Further, none of the references relied upon to disclose an illuminated strip, are used in conjunction with a body having a sealing portion for contacting a moveable confronting surface. The examiner has not identified any portion of the '240 and '180 references that discloses contacting a seal with a moveable surface.

For example, the present claims recite, "the sealing portion adapted to be spaced from the second confronting surface in the spaced apart open position of the confronting surfaces and the sealing portion adapted to contact the second confronting surface in the adjacent closed position of the confronting surfaces" (Claims 1-9); "a hollow bulb shaped sealing portion projecting from the weatherseal body and sized to contact the first confronting surface in the closed position" (Claims 13-17); [Claim 20] "a hollow bulb shaped sealing portion projecting from the elongate polymeric body and adapted to be spaced from the second confronting surface in a spaced apart open position of the confronting surfaces and the sealing portion adapted to contact a second confronting surface in the adjacent closed position of the confronting surfaces" (Claims 42-54); "the sealing portion adapted to be spaced from the second confronting surface in the spaced apart open position of the confronting surfaces and the sealing portion adapted to contact the second confronting surface in the adjacent closed position of the confronting surfaces" (Claims 55-64); and "a hollow bulb shaped sealing portion extending from the elongate polymeric body and adapted to be spaced from the second confronting surface in the spaced open position of the confronting surface and the sealing portion adapted to contact the second confronting surface in the adjacent closed position of the confronting surfaces" (Claims 65-74 and 76).

The primary reference being completely silent as to inclusion of an illuminating strip, is not cured by the secondary references ('180 and '240 references) which disclose illuminating door sills for buildings. Applicant respectfully submits the lack of any suggestion to combine building threshold sills with vehicular seals precludes the references from sustaining a rejection under 35 U.S.C. §103.

Therefore, applicant respectfully submits all the pending claims, Claims 1-9, 13-17, 20-23 and 42-76 are in condition for allowance and such action is earnestly solicited. If, however, the examiner feels that any further issues remain, he is cordially invited to contact the undersigned so that such matters may be promptly resolved.

Respectfully Submitted,
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